

UNITED STATES DEPARTMENT OF COMMERCE  
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Bayer 9998-CAO

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/976,063	11/21/97	STEINBUCHER	A BAYER-9998-C

HM11/0807  
SPRUNG KRAMER SCHAEFER & BRISCOE  
660 WHITE PLAINS ROAD 4TH FLOOR  
TARRYTOWN NY 10591-5144R111 due:  
11-7-98

EXAMINER

TUNG, P

ART UNIT PAPER NUMBER

1652

DATE MAILED:

08/07/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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AUG 13 1998

COMMUNICATIONS SECTION

**Office Action Summary**Application No.  
**08/978,063**Applicant(s)  
**Steinbuechel et al.**Examiner  
**Peter Tung**Group Art Unit  
**1652**

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**COPY****Disposition of Claims**

- ☒ Claim(s) 1-13 is/are pending in the application.
- Of the above, claim(s) 10-13 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-9 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

4. In the specification on pages 17, 19 and 20, sequences greater than 10 nucleotides or 4 amino acids are disclosed. These sequences need to comply with the sequence rules as stated above.

***Election/Restriction***

5. Claims 1 and 8 are generic to a plurality of disclosed patentably distinct species comprising coniferyl alcohol, coniferylaldehyde, ferulic acid, vanillin and vanillic acid. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

6. Claim 2 is generic to a plurality of disclosed patentably distinct species comprising eugenol hydroxylase, coniferyl alcohol dehydrogenase, coniferylaldehyde dehydrogenase, ferulic acid deacylase and vanillin dehydrogenase. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

7. If coniferyl alcohol and eugenol hydroxylase are elected, claim 9 will be included with claims 1-8 readable on the elected species.

If coniferylaldehyde and coniferyl alcohol dehydrogenase are elected, claim 10 will be included with claims 1-8 readable on the elected species.

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If ferulic acid and coniferylaldehyde dehydrogenase are elected, claim 11 will be included with claims 1-8 readable on the elected species.

If vanillin and ferulic acid deacylase are elected, claim 12 will be included with claims 1-8 readable on the elected species.

If vanillic acid and vanillin dehydrogenase are elected, claim 13 will be included with claims 1-8 readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. During a telephone conversation with Ms. Carmella O'Gorman on 7/20/98 a provisional election of species was made with traverse to prosecute the invention readable on the elected species coniferyl alcohol and eugenol hydroxylase, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any